UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,061	07/12/2001	Lawrence C. Cole	83336.640	1903

66880 7590 08/02/2012

STEPTOE & JOHNSON, LLP
2121 AVENUE OF THE STARS
SUITE 2800
LOS ANGELES, CA 90067

EXAMINER	
COBURN, CORBETT B	
ART UNIT	**PAPER NUMBER**
3714	

NOTIFICATION DATE	DELIVERY MODE
08/02/2012	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

emiyake@steptoe.com
mhein@ballytech.com
ccipdocketing@steptoe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAWRENCE C. COLE,
WAYNE W. WALKWITZ, and
PAUL C. MCLAUGHLIN

Appeal 2011-012067
Application 09/904,061
Technology Center 3700

Before HUBERT C. LORIN, MEREDITH C. PETRAVICK, and MICHAEL W. KIM, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Lawrence C. Cole, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-10. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.[1]

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. A method of allowing a United States-taxable player to participate in a reduced interruption gaming session when a jackpot over a threshold amount is won, the method utilizing a tracking device having a central server, and wherein the tracking device is connectable to one or more gaming machines, the method comprising:
>
> collecting player-related information;
>
> storing the player-related information;
>
> allowing the player to participate in a reduced interruption gaming session;
>
> recording jackpot-related information in the tracking device whenever a jackpot having a value greater than a threshold amount is won;

[1] Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed Feb. 17, 2010) and the Examiner's Answer ("Answer," mailed Jan. 7, 2011).

enabling paying out of the value of the jackpot to the United States-taxable player immediately after the player wins credits over the threshold amount subject to immediate cash out;

enabling the player to continue the reduced interruption gaming session, as desired;

terminating the reduced interruption gaming session; and

generating a statement referencing the recorded jackpot-related information and stored player-related information after the reduced interruption gaming session is terminated.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Bergeron	US 4,882,473	Nov. 21, 1989
Pease	US 5,326,104	Jul. 5, 1994
Bell	US 5,505,461	Apr. 9, 1996
Acres	US 6,312,333 B1	Nov. 6, 2001

The following rejections are before us for review:

1. Claims 1, 2, and 4-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bell and Acres.
2. Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Bell, Acres, Bergeron, and Pease.

ISSUE

The issue is whether the claimed method would have been obvious to one of ordinary skill in the art over the cited prior art combination. Specifically, would it have been obvious to "enabl[e] paying out of the value

of [a] jackpot to [a] United States-taxable player immediately after the player wins credits over [a] threshold amount subject to immediate cash out" (claim 1)?

FINDINGS OF FACT

We rely on and adopt the Examiner's factual findings (Answer 3-7). Additional findings of fact may appear in the Analysis below.

ANALYSIS

The rejection of claims 1, 2, and 4-10 under 35 U.S.C. §103(a) as being unpatentable over Bell and Acres.

The Appellants argued claims 1, 2, and 4-10 as a group (Br. 4). We select claim 1 as the representative claim for this group, and the remaining claims 2 and 4-10 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

> Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 417-418 (2007).

Both the Specification and Bell explain that the value of jackpots over the threshold amount promulgated by the IRS must be recorded on an IRS Form W-2G. Specification 1-3 and Bell, col. 1. ll. 37-42. It necessarily takes time to fill out the required form, notwithstanding that jackpot winners want

their winnings immediately. Clearly, those of ordinary skill in the art at the time of the invention knew that the impediment to "enabling paying out of the value of [a] jackpot to [a] United States-taxable player immediately after the player wins credits over [a] threshold amount subject to immediate cash out" (claim 1) lay in the requirement that a W2-G Form must be prepared.

> In order to comply with the regulations, a gaming establishment must stop play any time a jackpot over the threshold is won in order to collect the required information for later reporting to the taxing authorities.

Specification 2:6-8.

> Each time the slot machine exceeds the IRS determined threshold, the slot machine is automatically "locked up" and cannot be played until an attendant prepares a W2-G Form and uses a key to clear the slot machine and make it ready to play again. This is a very tedious process which can result in literally hundreds of W2-G Forms being prepared and issued over several days. W2-G Form preparation is manual, and could be subject to error. It takes approximately 5 minutes to prepare a single W2-G Form.

Bell, col. 1, ll. 38-46.

Thus, so long as the required information for later reporting to the taxing authorities via a W2-G Form has been obtained, one would be "enabl[ed to] pay[ ] out of the value of [a] jackpot to [a] United States-taxable player immediately after the player wins credits over [a] threshold amount subject to immediate cash out" (claim 1).

Given this common knowledge, it would have been obvious to one of ordinary skill in the art to "enabl[e] paying out of the value of [a] jackpot to [a] United States-taxable player immediately after the player wins credits over [a] threshold amount subject to immediate cash out" in the manner

claimed (claim 1).

The rejection is affirmed for the foregoing reasons.

The rejection of claim 3 under 35 U.S.C. §103(a) as being unpatentable over Bell, Acres, Bergeron, and Pease.

The Appellants do not challenge the rejection of claim 3 beyond what was argued in challenging the rejection of claim 1. Accordingly, for the same reasons we affirm the rejection of claim 1, we affirm the rejection of claim 3.

CONCLUSIONS

The rejections of claims 1, 2, and 4-10 under 35 U.S.C. §103(a) as being unpatentable over Bell and Acres and claim 3 under 35 U.S.C. §103(a) as being unpatentable over Bell, Acres, Bergeron, and Pease are affirmed.

DECISION

The decision of the Examiner to reject claims 1-10 is affirmed.

AFFIRMED

MP